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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,080	04/28/2005	Kazuhiko Kato	271511US0PCT	2324

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

MAEWALL, SNIGDHA

ART UNIT	PAPER NUMBER
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1612

NOTIFICATION DATE	DELIVERY MODE
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10/01/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/533,080	Applicant(s) KATO ET AL.	
	Examiner Snigdha Maewall	Art Unit 1612	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 September 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1,3 and 10-17.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Snigdha Maewall/
Examiner, Art Unit 1612

/Gollamudi S. Kishore/
Primary Examiner, AU 1612

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that JP does not teach potassium ions, the combination of references is impermissible and the claimed oral preparation provides an advantageous result. The advantage is that small amount of calcium phosphate provides light scattering layer inside enamel which causes an irregular reflection in response to an incident light radiated from the outside, applicant then points to specification for these properties. JP teaches whiteness and gloss and does not teach potassium ions. Applicant's arguments are not persuasive. First while it is true that JP does not teach potassium ions, secondary reference has been cited for potassium ions, therefore since the claimed composition is obvious over the teachings of prior art, one would expect the property of light scattering to be associated with the composition because property of compounds cannot be separated from them. Discovery of new property does not make old composition patentable. Independent claims 1 and 13 do not recite that potassium ions are used as whitening and light scattering agent, hence the results argued by applicants do not correlate light scattering effect with any dental hygiene. Motivation to combine the teachings of references need not be same as applicants motivation. Applicant further argues that by providing large amount of potassium ions, decreased amount of organic acid were used which provides good flavor to the claimed invention and thus these advantages are not provided in prior art. Applicant's arguments are not persuasive because JP teaches the overlapping amounts of organic acids, therefore the composition would be expected to have good flavor. The claimed invention is directed to composition and not to the method of enhancement of light scattering layer and furthermore, applicants have not claimed correlation of light scattering effect with dental hygiene wherein the claims are drawn to oral preparation for application to teeth. Instant claims do not recite whitening oral composition or do not state that potassium ions are added as whitening agent. Applicant argues that JP already diminishes teeth sensitivity therefore one would not be motivated to add EP's desensitizer, these arguments are not persuasive because JP also teaches adding additional ingredients known in dental art, as such one would be motivated to add potassium as desensitizer for better feel/sensitivity in mouth since it is known in the art to add compounds known for their intended use. Instant claims are drawn to composition and intended use of composition does not provide patentability unless it provides structural changes to composition, applicant is arguing the process of forming light scattering layer, however the claims are drawn to composition claims. The specification teaches tooth paste composition and mouthwash composition and include specific acids and specific amount of potassium ions and acids and the light scattering result is shown with 0.13 mol/kg of potassium wherein the claims recite the lower limit to be 0.03 mol/kg and no results have been shown in instant specification for such lower limit for light scattering effect. Instant claims generically recite organic acid and independent claims are not specific to malic, tartaric or lactic acid, therefore the results argued by applicants do not commensurate with the scope of instant claims. The rejections will be maintained.